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Attorney Docket No. GEMS8081.168

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Gupta et al.
Serial No. : 10/633,290
Filed : August 1, 2003
For : Method and Apparatus for Displaying Real-Time Status of Product
Availability, Order, and Sales Revenue
Group Art No. : 2167
Examiner : Robert M. Timblin

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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PRE-APPEAL BRIEF CONFERENCE REQUEST

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments have been made with this request. The request is being filed with a Notice of Appeal. The review is requested for reasons as set forth hereinafter:

MAR 21 2007**REMARKS**

In the Final Office Action mailed November 21, 2006, the Examiner rejected claims 33-37 under 35 U.S.C. §101 as being non-statutory. The Examiner also rejected claims 22, 24, 26-31, 33-34, and 36-39 under 35 U.S.C. §103(a) as being unpatentable over Kennedy et al. (USP 6,963,847) ("Kennedy '847") in view of Kennedy et al. (USP 6,055,519) ("Kennedy '519"). Claims 23, 25, 32, and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy '847, Kennedy '519, and further in view of Tucker et al. (USP 5,452,218). In the Advisory Action mailed February 13, 2007, the Examiner maintained all rejections.

Applicant now seeks Pre-Appeal review of the above rejections, and requests withdrawal of the Examiner's rejections and issuance of a Notice of Allowance. In particular, the Examiner's substantive rejections have ignored specific limitations in the claims and therefore have not procedurally complied with the requirements for making an obviousness rejection under MPEP § 706.02(j). The Examiner's non-statutory subject matter rejection is also procedurally erroneous in that it does not follow MPEP guidelines for establishing a rejection under § 101.

In the Final Office Action, the Examiner substantively rejected claim 22 under § 103(a), citing Kennedy '847 in combination with Kennedy '519 as teaching all elements of the claim. As to the step of claim 22 reciting "automatically determining a shipment quality metric for all orders that have shipped," the Examiner cited Kennedy '847 at Col. 25, Ins. 25-39 and Col. 33, Ins. 42-55. In Applicant's Response dated January 22, 2007, Applicant noted to the Examiner that the majority of the citations to both Kennedy '847 and Kennedy '519 are directed to product ordering negotiations and information regarding manufacturing output that is "available to promise" or ATP. *Kennedy '847*, Col. 2, Ins. 25-31; *Kennedy '519*, Col. 2, Ins. 20-41. In this regard, Kennedy '847 includes a number of ATP servers 14 and Kennedy '519 includes a "negotiation engine" 16 and a scheduler 20 which assist users in coordinating the terms of **potential** orders. The citation to Col. 25, Ins. 25-39 of Kennedy '847 discusses "delivery coordination" for planning distribution and delivery to customers, not measurement of orders which have already shipped. *See, e.g., Kennedy '847*, Col. 25, Ins. 35-38 ("the delivery dates corresponding to the individual ATP requests 30 may be adjusted to reflect an optimized overall delivery plan") (emphasis added). That is, the cited section of Kennedy '847 discusses pre-shipment plans for orders which have not yet shipped.

Applicant also noted in the Response dated January 22, 2007 that the citation to Col. 33, Ins. 42-55 merely regards the archiving of data and does not teach or suggest determination of a shipment quality metric for all orders that have shipped, as claimed. *See Kennedy '847*, Col. 33, Ins. 51-61. However, in the Advisory Action mailed February 13, 2007, the Examiner disagreed with Applicant and stated that Kennedy '847 "is concerned with shipped orders" and "monitors shipment confirmations." *Advisory Action*, 02/13/07, pg. 2 (emphasis added). The Examiner also postulated, without further citation, that

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"when a shipment is completed (i.e. the orders have been shipped) a status is updated in notification of fulfillment." *Id.* (emphasis added). The portion of Kennedy '847 in question reads as follows:

Once acceptance 50 has been suitably processed, fulfillment server 16 monitors for component fulfillment notifications from LFM's 22. ATP request 30 is considered fulfilled when each component ATP request 32 has received a component fulfillment notification. A unified fulfillment notification is generated and sent to the requesting client 12 using network 18. When component ATP requests 32 have been fulfilled, fulfillment server 16 may also monitor corresponding shipment confirmations. When ATP request 30 has been fully shipped, its status is updated and fulfillment server 16 notifies the requesting client 12. Fulfillment server 16 may provide archive capabilities for fulfilled ATP requests 30, which may be configurable to allow client 12 to specify archive parameters such as when ATP requests 30 are to be archived and the number of periods of request history to be maintained. Archives may be maintained at fulfillment server 16, at one or more locations associated with LFM's 22, or at any other suitable location internal or external to system 10

Kennedy '847, Col. 33, lns. 43-61. Applicant does not disagree with the Examiner that this portion of Kennedy '847 concerns shipped ATP requests. Kennedy '847 is unclear as to what a "shipment confirmation" means, but Applicant notes that Kennedy '847 does not contain disclosure relating to whether a shipped ATP request actually arrived at its customer destination. Regardless, a "fulfillment notification" or an archived "ATP request" is not a shipment quality metric for an ATP request or order that has shipped. In other words, Applicant and the Examiner do not necessarily disagree on some of the teachings of Kennedy '847; the Examiner has simply not addressed a specific limitation of claim 22. A user of the system of Kennedy '847 does not measure the quality of a fulfilled ATP request by merely knowing that it was fulfilled. Kennedy '519 also does not teach or suggest the claimed shipment quality metric, and the Examiner did not cite the reference as such. Therefore, the Examiner has not identified any teaching in the cited art of record by which the quality of shipped orders can be measured – i.e. a shipment quality metric. Accordingly, the Examiner has not established a *prima facie* case of obviousness. As such, Applicant respectfully requests withdrawal of the Examiner's rejection of claim 22 and all claims depending therefrom.

Likewise, claim 26 recites a computer caused to "determine a shipment quality metric for shipped orders." As discussed above, Kennedy '847 and Kennedy '519 primarily regard order negotiations and do not teach or suggest the determination or display of shipment quality metrics for orders that have already shipped. Therefore, Applicant respectfully requests withdrawal of the rejection of claim 26 and all claims depending therefrom.

In rejecting claim 33, the Examiner stated merely that "the limitations of this claim are similar to those set forth in claims 22 and 26 above in view of Kennedy ['847]. Therefore, claim 33 is rejected for the same reasons." *Final Office Action*, 11/21/06, pg. 7. Such a rejection is procedurally erroneous on its

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face since claim 33 is an independent claim having different limitations than claims 22 and 26, and deserves independent examination. Further, the Examiner did not address specific limitations of claim 33, such as "calculate a total revenue for the orders in production for each product category" and "display, in a table, the total revenue and proactive alert for each different if the promised shipping date is later than the requested shipping date." The Examiner did not cite to any portion of Kennedy '847 or Kennedy '519 which teach the display of such proactive alerts together with total revenue in a table, as claimed. Kennedy '847 discusses total prices as part of a quotation during a negotiation, but does not teach or suggest total revenue figures for orders which are in product, broken down by product categories. See Kennedy '847, Col. 19, Ins. 35-43; Col. 21, Ins. 40-43. Kennedy '519 teaches the existence of "problems" which relate to delivery dates at Col. 17, Ins. 59-67 but this teaching does not mention ship dates and does not clearly indicate exactly how each "problem" is conveyed to the user, nor what, if anything, may be conveyed in addition to the problems. Since the citations to Kennedy '847 and Kennedy '519 were provided with respect to other claims and do not teach or suggest all the elements of claim 33, the Examiner has not established a *prima facie* case of obviousness for claim 33. Therefore, Applicant respectfully requests withdrawal of the rejection of claim 33 and all claims depending therefrom.

Similar problems exist with respect to numerous dependent claims. For example, claim 29 recites the display of a first message "if the number of days before the product is available is greater than a user-defined number" and the display of a second message "if the number of days before the product is available is less than a user-defined number." The Examiner's rejection of claim 29 cites to portions of Kennedy '847 which do not regard displaying messages at all. See *Final Office Action*, 11/21/06, pg. 6-7; Kennedy '847, Col. 10, Ins. 40-50, Col. 11, Ins. 38-58. As another example, the Examiner cited Tucker at Col. 3, Ins. 15-29 and Fig. 7 as teaching the formula presented in claim 23:

$$Z_{LT} = \min\left[\frac{USL - \mu}{\sigma}, \frac{\mu - LSL}{\sigma}\right]$$

See *Final Office Action*, 11/21/06, pg. 8. The Examiner stated that "[i]t would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because the teaching of Tucker would have provided Kennedy's system with producing a measure of quality." *Id.* However, the cited portions of Tucker reflect a different statistical analysis regarding "the probability that an observation from the standard normal distribution is less than or equal to" maximum tolerance over standard deviation plus minimum tolerance over standard deviation. See Tucker, Fig. 7; Col. 3, Ins. 20-24 (resulting in a defects per unit value). One skilled in the art will appreciate that the formula presented in claim 23 is different because it utilizes a minimizing operation to produce a different value. As another example, claims 24 and 37 recite a plurality of display forms

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wherein each display form depends on the number of days before the product is available. As to this limitation, the Examiner cited Col. 2, lns. 28-40 of Kennedy '847 without any explanation. *Final Office Action*, 11/21/06, pg. 5. However, the cited portion of Kennedy '847 is a summarization of the system thereof and does not discuss displays, forms, or the number of days before a product is available.

It remains that the Examiner has issued conclusory rejections of the above-noted claims, as well as other claims, without showing that the specific elements thereof are found in the art of record. Therefore, the Examiner did not establish a *prima facie* case of obviousness, and Applicant respectfully requests withdrawal of the Examiner's substantive rejections.

With respect to the rejection of claims 33-37 under §101, Applicant respectfully disagrees that signals are *per se* non-statutory. In the *Final Office Action*, the Examiner stated that computer signals "do not belong to any of the 4 enumerated statutory classes of invention" and are "nonstatutory natural phenomena" since they "recite nothing but the physical characteristics of a form of energy." *Final Office Action*, 11/21/06, pg. 3. In the subsequent *Advisory Action*, the Examiner reiterated that a signal is not a process, a machine, a composition of matter, or a manufacture. *Advisory Action*, 02/13/07, pg. 2. At no point has the Examiner established all the requirements for making a §101 rejection as set forth in MPEP §2106.

According to MPEP §2106, the first step in determining whether a claim falls within the broad ambit of §101 is to determine "whether the claim falls within at least one of the four enumerated categories." The Examiner concluded that any signal claim *per se* does not fall within one of the four categories and ceased further inquiry. However, "the patentability analysis does not end there. USPTO personnel must further continue with the statutory subject matter analysis as set forth" in the remainder of MPEP §2106. *Id.* Since the Examiner indicated that signal claims are "natural phenomena," the Examiner must also show that the claims are not a practical application of a natural phenomena. MPEP §2106 IV(C)2. The Examiner bears the burden of proving that the claims are not a practical application of a natural phenomena by showing that the claims do not recite a physical transformation or a useful, concrete, and tangible result. MPEP §2106(IV)(C)2(1-2).

Here, it is clear that claim 33 is useful, for example, in that it recites a number of steps and calculations performed in regard to data concerning an actual product production, including revenue calculations and shipping date comparisons. The Examiner has not challenged the utility of claim 33. *See* MPEP §2106(IV)(C)2(2)(a). Claim 33 has a tangible result at least due to the recitation that the one or more processors are caused to "display, in a table, the total revenue and a proactive alert." *See* MPEP §2106(IV)(C)2(2)(b). Furthermore, claim 33 is also concrete in that its results are "substantially repeatable." *See* MPEP §2106(IV)(C)2(2)(c). Therefore, since the Examiner has not shown that claim 33

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is not a practical application of a natural phenomena, the Examiner has not established that claim 33 recites non-statutory subject matter.

As Applicant has noted previously, MPEP §2106.02, specifically directed to computer-related inventions, does not compel a different result. MPEP §2106.02 states that non-functional descriptive material embodied in electromagnetic signals may be non-statutory, but does not state that functional descriptive material, such as computer instructions embodied in signals, is non-statutory. In fact, MPEP §2106.02 indicates that where a claim recites sufficient interrelationships between a claimed set of instructions or "computer program," such that the program's functionality is realized via a computer, such claim will be considered statutory. *Id.* ("Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory"). Accordingly, Applicant requests withdrawal of the Examiner's rejection under § 101 of claim 33 and all claims depending therefrom.

Applicant appreciates the Panel's consideration of these Remarks and cordially invites the Panel to call the undersigned, should the Panel consider any matters unresolved.

Respectfully submitted,

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